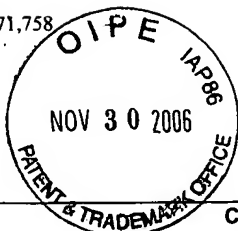


PATENT



#AP 85W

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Date: November 27, 2006

Michele Muller

(Name of person mailing paper)

Michele Muller

(Signature of person mailing paper)

Attorney Docket No. FR-AM1888NP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PRADEL, Jean-Laurent, et al

Group Art Unit: 1772

Serial No.: 10/671,758

Examiner: PATTERSON, Marc A

Filed: September 26, 2003

For: " COEXTRUSION TIE FOR POLYESTER BASED ON COGRAFTED METALLOCENE
POLYETHYLENE AND LLDPE AND ON METALLOCENE POLYETHYLENE "

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby appeal the decision of the Primary Examiner finally rejecting claims 1-10, and 12-14 of the above-identified Application. Applicant filed a Notice of Appeal pursuant to 37 C.F.R. §1.191 on September 26, 2006 along with a Pre-Appeal Brief Request for Review..

An authorization and fee in duplicate accompanies the filing of this Brief pursuant to 37 C.F.R. §1.17(c). The brief is being filed in triplicate.

I. Real Party in Interest

The real Party in interest, as evidenced by the assignment document Reel/Frame 014595/0836 recorded May 4, 2004.

II. Related Appeals and Interferences

There are no other appeals or interferences known to Appellant which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-10, and 12-14 are pending. Claims 1-10, and 12-14 stand rejected. Claim 11 has been canceled without prejudice or disclaimer. Attached hereto is a copy of the claims as currently pending (**Appendix A**).

IV. Status of Amendments

All proposed amendments have been entered. No amendments were presented after final rejection.

V. Summary of Invention

The summary of the invention is irrelevant to the question raised on appeal.

The Invention relates to a coextrusion tie layer which adheres to polyester, and which is a blend of ungrafted metallocene polyethylene with a blend of cografted metallocene polyethylene and cografted non-metallocene linear low density polyethylene.

VI: Issues

The single issue on Appeal is:

Can a foreign equivalent patent of a properly Terminally Disclaimed U.S. patent be cited as valid 35 U.S.C. §103(a) reference in substitution for the equivalent terminally disclaimed U.S. patent?

VII. Groupings of Claims

The patentability of all dependent claims are to stand or fall with the independent Claims 1, 6, and 9, on which they depend.

VIII: Argument

KEY FACTS:

Present application prosecution History:

09/27/2002 - FR 02.11992 application was filed in France as the priority document.

09/26/2003 - US patent application 10/671,758 filed, claiming priority to FR 02.11992.

02/08/2005 - First Office Action Rejection: §112 and double patenting rejections over US 6,528,587 in view of X, as the only rejections.

4/29/2006 - A response and terminal disclaimer over US 6,528,587 with proper fees filed.

7/26/2005 - Non-final rejection: over EP 1136536 (EP equivalent of terminally disclaimed US 6,528,587) using US 6,528,587 as the translation!

10/25/2006 - Response, claiming that a citation of the EP equivalent of the terminally disclaimer US case as prior art is improper.

01/12/2006 - Non-final rejection: over same EP 1136536 art.

06/12/2006 - Response (with 1-month extension fee) again arguing improper citation of the European equivalent of the US terminally disclaimed patent.

07/26/2006 - Final rejection, again based on EP 1136536.

09/26/2006 - A Notice of Appeal and Pre-Appeal Brief Request for Review was filed.

11/03/2006 - Notice of the Panel Decision to proceed to the Board of Patent Appeals

Prosecution history of US 6,528,587 and EP 1136536

03/24/2000 - FR 0003797 was filed

03/16/2001 - EP 1,136,536 B1 was filed. Published September 26, 2001

03/26/2001 - US 6,528,587 B2 filed (first business day - Monday - after the 1-year anniversary of the priority document), and published December 20, 2001.

03/04/2003 - US 6,528,587 granted

The Examiner erred in applying the EP equivalent patent of a US terminally disclaimed patent, in substitution for said US terminally disclaimed patent. Applicant contends that such use:

- A. Is against the stated purpose of a Terminal disclaimer.**
- B. Is against public policy**
- C. Is against international treaties**
- D. Allows the Examiner to obtain a terminal disclaimer, then turn around and substitute the foreign equivalent of the disclaimed patent, making a mockery of the terminal disclaimer and Examination process.**
- E. Would lead to the invalidation of many US patents**
- F. Could provide a means for the US Patent Office to change established policy and limit terminal disclaimers, thus more closely matching International Patent Practice**

Applicant knows of no case law on point.

Applicant acknowledges that the EP 1136536 application, published one year and one day before Applicant's priority document, would be a valid prior art reference.

Applicant notes that the Examiner in this case recognizes the equivalence of the US 6,528,587 and EP 1136536 documents – since the Examiner uses the US patent as the English translation of the EP application. The US '587 and EP '536 equivalent patents of course have the same priority date of March 24, 2000.

A. Is against the stated purpose of a Terminal disclaimer.

If a terminal disclaimer over a US patent is not also a terminal disclaimer over all foreign equivalent cases having the same priority date, then the terminal disclaimer ceases to function in the manner anticipated in the law. The main function of the Terminal Disclaimer is that it obviates the primary objection to double patenting, which is the extension of monopoly. In re Robeson, 331 F.2d 610, 141 USPQ 485 (1964). To accomplish this purpose, the terminal disclaimer should place the claims in the same position with respect to the EP ('536) subject matter as the US ('587). Since the present claims now terminate with the US ('587) patent claims, there is no monopoly extension over either US ('587) or the equivalent (EP '536).

The effect of a terminal disclaimer is to tie the affected patents together [Ortho Pharmaceutical Corp v. Smith, 959 F.2d 936, 22 USPQ 2d 1119, 1123 (Fed. Cir 1992)]. Tying the US patent, without also tying all foreign equivalent applications having the same priority, produces an incomplete tying.

B. Is against public policy

One important purpose of a Terminal Disclaimer is to public policy, as improvements are placed into the public domain. In this regard, the framers of the present regulations placed no limits on length of time that can be terminally disclaimed. The effect of the rejection in the present case is to limit the use of a terminal disclaimer only to applications that have not published in a foreign office more than one year before the filing of the application at bar..

The effect of a terminal disclaimer that applies only to the US patent, and not to any foreign equivalents, in effect limits the use of a terminal disclaimer for any internationally filed patent, to only US cases filed less than 30 months prior to the application filing date. Foreign patent applications publish at 18 months, making the disclaimer of any US patent older than 30 months and filed internationally a useless exercise (18 months to publish, and must publish more than 12 months before US case). The Examiner could disregard any Terminal disclaimer over the US reference and cite the foreign equivalent as prior art instead.

The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. MPEP 804.02(II). *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); *In re Eckel*, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

C. Is against international treaties

The Paris Convention, in Article 4 (A) (2) provides that “Any filing that is equivalent to a regular national filing...be recognized as giving rise to the right of priority”. Since the terminal disclaimer of a US case essentially starts the 20 year term at the priority date of the terminally disclaimed patent, then foreign equivalent applications and patents having the same priority date should also effectively be disclaimed.

For references filed under the PCT, then by 35 U.S.C. §102(e) and §103(a) any international application shall have the effects of an application filed in the US. Since PCT applications are given the same effect as US references under 35 U.S.C. §102(e), then it would follow that the same effect should apply to a terminal disclaimer over a PCT application. This statute does not apply to Paris Convention States, but this similar type thinking is needed to make international sense of the terminal disclaimer.

D. Allows the Examiner to obtain a terminal disclaimer, then turn around and substitute the foreign equivalent of the disclaimed patent, making a mockery of the terminal disclaimer and Examination process. A foreign equivalent of a US Terminally-disclaimed reference (with the same priority date) should not be allowed to be used as a substitute 35 U.S.C. §103 reference. The substitute of equivalent references makes a mockery of US Terminal Disclaimer practice, allowing Examiners to circumvent most Terminal Disclaimers. Once a US applicant decides to shorten the length of monopoly protection in exchange for removal or a prior art reference it is unfair for the Patent office to accept such a terminal disclaimer, then use a foreign equivalent patent to make the same arguments. This would amount to a taking of Applicant's property right without any consideration.

E. Would lead to the invalidation of many US patents

Many currently granted US patents have been allowed with terminal disclaimers. Any of these granted US patents in which the terminally disclaimed patent was foreign published prior to the invention, would now be rendered invalid over the foreign equivalent patent. Applicant is concerned that this change of policy could reek havoc with several of Applicant's granted US patents, and cause a general crisis for many other patent holders.

F. Could provide a means for the US Patent Office to change established policy and limit terminal disclaimers, thus more closely matching International Patent Practice. The terminal disclaimer is unique to US patent practice. As the US strives for harmonization with world patent practices, limitation of terminal disclaimer practice in which a foreign equivalent patents can be substituted for a terminally disclaimed patents would be a step toward elimination of the terminal disclaimer.

CONCLUSION

Appellant submits that the substitution of a foreign equivalent patent as a 35 USC §103(a) reference for a terminally disclaimed US patent is improper and unfair. The rejection of record should not be sustained, and the Board is requested to reverse the Examiner's rejection.

Respectfully submitted


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Date: November 27, 2006

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APPENDIX A

Claims as they currently stand

LISTING OF THE CLAIMS

1. A coextrusion tie, which comprises:

- 5 to 35% by weight of a polymer (A) itself composed of a blend of 80 to 20% by weight of a metallocene polyethylene (A1) with a density of between 0.863 and 0.915 and of 20 to 80% by weight of a non-metallocene LLDPE polyethylene (A2) with a density of between 0.900 and 0.950, the blend of polymers (A1) and (A2) being grafted by a grafting monomer chosen from unsaturated carboxylic acids and their derivatives, the content of the grafting monomer in said blend being between 30 and 100 000 ppm, preferably between 600 and 5 000 ppm;
- 95 to 65% by weight of metallocene polyethylene (B) homo- or copolymer, the comonomer of which comprises 3 to 20 carbon atoms, the density of which is between 0.863 and 0.915 and the MFI, melt flow index, of which, measured under 2.16 kg at 190°C according to Standard ASTM D 1238, is between 0.5 and 30, g/10 min;

the total forming 100%, the blend of (A) and (B) being such that its MFI is between 0.1 and 15, g/10 min.

2. The tie as claimed in claim 1, the adhesive strength of which is increased by 5 to 50% between the time $t=0$ corresponding to its application immediately after its extrusion and the time $t=8$ days.
3. The tie as claimed in claim 1, wherein the grafting monomer is maleic anhydride.
4. The tie as claimed in claim 1, which additionally comprises an ethylene/alkyl (meth)acrylate copolymer (C).
5. The tie as claimed in claim 1, wherein the MFI of A is between 0.1 and 5 g/10 min (ASTM D 1238 at 190°C under 2.16 kg).

6. A multilayer structure, which comprises a layer (L) comprising the tie of any one of the preceding claims and a layer (E) directly attached to one of the two faces of said layer (L), said layer (E) being a polyolefin or polyester layer.
7. The multilayer structure as claimed in claim 6, wherein a layer (F) is directly attached to the second face of the layer (L), the layer (L) being sandwiched between the layers (E) and (F), said layer (F) being either a polymer layer, the polymer being chosen from the group of the polyamides, saponified copolymers of ethylene and of vinyl acetate (EVOH), polyolefins and polyesters, or a metal layer.
8. The multilayer structure as claimed in claim 7, wherein the layer (E) is a polyester copolymer layer and the layer (F) is an EVOH layer.
9. An object, which comprises a structure as claimed in claim 6.
10. The object as claimed in claim 9, which is a bag, a bottle, a container, a film, a sheet, a pipe or a hose.
11. (canceled)
12. The coextrusion tie of claim 1 wherein said metallocene polyethylene (B) copolymer comonomer comprises 4 to 8 carbon atoms.
13. The coextrusion tie of claim 1 wherein said metallocene polyethylene (B) has an MFI, melt flow index, of which, measured under 2.16 kg at 190°C according to Standard ASTM D 1238, is between 3 and 15, g/10 min.
14. The coextrusion tie of claim 1 wherein the blend of (A) and (B) being such that its MFI is between 1 and 13 g/10 min.

Doc Code:

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PTO/SB/17 (07-06)

Approved for use through 01/31/2007. OMB 0651-0032
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL
for FY 2006**☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) \$500.00

Complete if Known

Application Number	10/671,758
Filing Date	9/26/2003
First Named Inventor	PRADEL, Jean-Laurent, et al
Examiner Name	PATTERSON, Marc A.
Art Unit	1772
Attorney Docket No.	FR-AM1888 NP

METHOD OF PAYMENT (check all that apply)

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☒ Charge any additional fee(s) or any underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid(\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	\$50.00	= \$0.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	\$200.00	= \$0.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listing under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	0	/ 50 0 (round up to a whole)	x \$250.00	= \$0.00

4. OTHER FEE(S)

Non-English specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Filing a brief in support of an appeal

\$500.00

SUBMITTED BY

Signature	<i>Thomas F. Roland</i>	Registration No. (Attorney/Agent)	42,110	Telephone	215-419-7314
Name (Print/Type)	Thomas F. Roland, Esq.			Date	11/27/2006

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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